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REMARKS

Claims 1-23, 34-69, and 83-107 have been cancelled herein as being drawn to a non-elected invention. Claims 24-33 and 70-82 will be pending upon entry of this Amendment D. Applicants expressly reserve the right to file divisional applications directed towards these non-elected claims in the future. Applicants respectfully request reconsideration and allowance of all pending claims.

1. Rejection of Claims 24-33 and 70-82 Under 35 U.S.C.

§103(a)

Reconsideration is requested of the rejection of claims 24-33 and 70-82 under 35 U.S.C. §103(a) as being unpatentable over Tanzer (WO 01/15646) in view of Yang et al. (U.S. 5,539,056).

Claim 24 is directed to a laminate structure comprising at least a portion of a first layer attached to at least a portion of a second layer using an adhesive composition. The adhesive composition comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight between about 1,000 and about 300,000, and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight between about 3,000 and about 200,000. The first layer is a neck-bonded laminate substrate.

Tanzer discloses an absorbent composite comprising a selectively stretchable liquid permeable first substrate layer, a selectively stretchable second substrate layer and pockets of superabsorbent material formed between the first layer and second

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layer.<sup>1</sup> In one embodiment, the layers may be a neck-bonded laminate of a necked, inelastic nonwoven filament web to an elastic film.<sup>2</sup> The pockets are defined by attachment means which serves to join the first and second layers to form a laminate. Suitable attachment means include water sensitive adhesives.<sup>3</sup> Alternatively, the attachment means can include water insensitive adhesives.<sup>4</sup>

As noted by the Office, Tanzer fails to teach the adhesive composition of claim 24, which comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight between about 1,000 and about 300,000, and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight between about 3,000 and about 200,000. In an attempt to find each and every element of claim 24 as required by the M.P.E.P. for a determination of prima facie obviousness, the Office cites the Yang et al. reference for combination with Tanzer.

Yang et al. disclose thermoplastic elastomers comprising alpha-olefins. Specifically, the thermoplastic elastomers comprise (1) an amorphous polyalphaolefin having a weight average molecular weight of at least about 150,000; and (2) crystalline polyalphaolefin having a molecular weight of less than about 300,000, provided that the molecular weight of the amorphous polyalphaolefin is greater than the molecular weight of the

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<sup>1</sup>Tanzer specification at page 6, lines 1-5.

<sup>2</sup>See Tanzer specification at page 3, lines 17-18.

<sup>3</sup>See Tanzer specification at page 6, lines 15-20.

<sup>4</sup>See Tanzer specification at page 6, lines 26-27.

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crystalline polyalphaolefin. In a laundry list of eighteen (18) uses, Yang et al. disclose adhesives as one use for their thermoplastic elastomers.<sup>5</sup>

As noted in M.P.E.P. §2142, in establishing obviousness, the Office must show a reference that teaches all of the claimed limitations along with some motivation or suggestion, either in the reference or in knowledge generally available to one skilled in the art, to modify the reference and arrive at the claimed subject matter. As further set forth in M.P.E.P. §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the reference itself, or in the knowledge generally available to one of ordinary skill in the art.

The Office states that it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the hot-melt adhesive composition of Yang et al. in the absorbent composite of Tanzer motivated by the desire to produce a high-performance product having an adhesive that is very flexible and strong. Applicants assert that such motivation to combine the Tanzer and Yang et al. references is lacking in this case, as there is no teaching or suggestion to use the alpha olefin blends of Yang et al. as an adhesive composition to attach the first and second substrate layers of Tanzer.

As stated above, Tanzer simply teaches that pockets between a first substrate layer and a second substrate layer are defined by attachment means, including water sensitive or insensitive adhesives. The Tanzer reference fails to provide a reason why

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<sup>5</sup>Yang et al. reference at column 20, lines 21-36.

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one skilled in the art would choose one adhesive over the other. As such, the Tanzer reference teaches that any adhesive would bind its first substrate layer to its second substrate layer. If the water sensitive adhesive and water insensitive adhesive are equivalents, what is the motivation for using the adhesive found in the Yang et al. reference over any other reference disclosing an adhesive? As noted above, obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references or in the knowledge generally available to one of ordinary skill in the art.<sup>6</sup> The mere fact that references can be combined to arrive at the claimed subject matter does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination.<sup>7</sup>

Yang et al. also fail to provide a motivation or suggestion to combine the references. Yang et al. disclose the use of their blends as an adhesive in a list of 18 uses. The Federal Circuit has held that a laundry list disclosure will not reasonably lead one skilled in the art to any particular species.<sup>8</sup> As such, there is no motivation or suggestion to pick one use, that of an adhesive, over any of the other uses disclosed in the Yang et al. reference for possible combination with the substrates of the Tanzer reference.

The Office apparently finds motivation to combine the Yang

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<sup>6</sup>M.P.E.P. §2143.01 citing In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

<sup>7</sup>In re Mill, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

<sup>8</sup>See Fujikawa v. Wattanasin, 93 F.3d 1559, 1571 (Fed. Cir. 1996).

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et al. and Tanzer references as Yang et al. disclose that their blends may be used in diaper waist bands.<sup>9</sup> Applicants respectfully disagree. A close reading of Yang et al. suggests that diaper waist bands may be produced using elastic films produced using the blends.<sup>10</sup> Nor where does the Yang et al. reference disclose using its adhesive to attach a neck-bonded laminate substrate to a second substrate as required in the instant claim 24. As disclosed in the instant specification, a neck-bonded laminate comprises a polyethylene layer sandwiched between two polypropylene, spunbonded layers; a polypropylene, spunbonded layer; or an outercover comprising a polyethylene layer and a polypropylene, spunbonded layer.<sup>11</sup> No where does the Yang et al. reference disclose these layers in the diaper waist bands produced using its adhesive or otherwise.

With all due respect, it appears that the Office has used improper hindsight analysis and reconstruction when combining the Tanzer reference with the Yang et al. reference. The Federal Circuit has repeatedly cautioned against hindsight analysis and held that such practice is improper.<sup>12</sup> As such, there is no

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<sup>9</sup>See Office Action dated July 13, 2004 at page 4.

<sup>10</sup>See Yang et al. reference at column 27, line 43 through column 28, line 2.

<sup>11</sup>Instant specification on page 28, lines 11-15.

<sup>12</sup>Grain Processing Corp. v. American-Maize-Products, Co., 840 F.2d 902, 904 (Fed. Cir. 1988). M.P.E.P. §2142 provides that in order to reach a proper determination under 35 U.S.C. §103(a), the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. Knowledge of Applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the

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motivation to combine the Tanzer and Yang et al. references to arrive at the instant claim 24, and claim 24 cannot be said to be obvious in view of the cited references.

Claims 25-33 are dependent upon claim 24 and are patentable for the same reasons as claim 24 set forth above, as well as for the additional elements they require.

Claim 70 is similar to claim 24 and is directed to a laminate structure comprising a first neck-bonded laminate substrate and a second neck-bonded laminate substrate, wherein the first neck-bonded laminate substrate is bonded to the second neck-bonded laminate substrate with an adhesive composition. The adhesive composition comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight of from about 1,000 to about 300,000 and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight of from about 3,000 to about 200,000.

Both Tanzer and Yang et al. are discussed above.

As stated above, Tanzer fails to disclose an adhesive composition comprising an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight of from about 1,000 to about 300,000 and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight of from about 3,000 to about 200,000. Further, as stated above, one skilled in the art would not and could not find motivation to combine the

"differences." The tendency to resort to "hindsight" based upon Applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

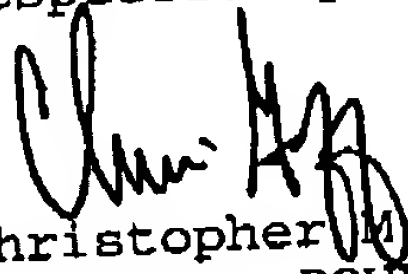
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composition of Yang et al. with the substrates of Tanzer to arrive at instant claim 70. As such, claim 70 is not obvious over the cited references.

Claims 71-82 are dependent upon claim 70 and are patentable for the same reasons as claim 70 set forth above, as well as for the additional elements they require.

In view of the above, Applicants respectfully request favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Amendment D to Deposit Account Number 19-1345 in the name of Senniger, Powers, Leavitt & Roedel.

Respectfully Submitted,

  
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